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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/868,708 | 10/22/2001 | Eric Jeffrey Lannert | 05222.00167 | 3465 |

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BANNER & WITCOFF AND ATTORNEYS FOR ACCENTURE
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CHICAGO, IL 60606

| EXAMINER | |
|---|---|
| HIRL, JOSEPH P | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2121 | |

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/868,708 | LANNERT ET AL. | |
| | Examiner | Art Unit | |
| | Joseph P. Hirl | 2121 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 October 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 October 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20011022*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. Claims 1-18 are pending in this application.

### *Request for Information*

2. In accordance with 37 C.F.R. 1.105, please provide all related information concerning the subject application and the February 7, 2002, Response (not received), applicable to Smialek and application 09/219,478. Since the subject application and the application at issue are closely related in content and time, it must be established that Smialek et al do not have a valid claim to the subject application (inventorship) and that the material so identified is not prior art. The answer must be a weighted response on a point-by-point basis.

### *Information Disclosure Statement*

3. The information disclosure statement filed February 7, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. All U.S. Patents have been

considered. However, in accordance with MPEP 609, no copies of other references have been received, none are available to examiner and consequently, those references have not been considered. IDS's dated June 18, 2002 and August 8, 2002 appear to have been incorrectly filed and were consequently not considered in this case.

### *Drawings*

4. The drawings are objected to for the following reasons:

Figs. 1-30 contain references to WO 00/38140, PCT/US99/02715 and Substitute Sheet (Rule 26). This application is for a U.S. Patent and ancillary notation that obscures the clarity of the disclosure should be removed (MPEP 702).

This objection must be corrected.

### *Specification*

5. The specification is objected to for the following reasons:

Pages 1-46 contain references to WO 00/38140, PCT/US99/02715 and Substitute Sheet (Rule 26). This application is for a U.S. Patent and ancillary notation that obscures the clarity of the disclosure should be removed (MPEP 702).

This objection must be corrected.

***Abstract***

6. The abstract is objected because it was not provided.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

*Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

8. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1-10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 of prior U.S. Patent No. 6,549,893 This is a double patenting rejection.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

11. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

12. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 10-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-19 of U.S. Patent No. 6,016,486. Although the conflicting claims are not identical, they are not patentably distinct from each other because a computer program embodied on a computer-readable medium that create a presentation related to a temporal model is obviously similar to an apparatus that creates a presentation related to a temporal model, especially since the species anticipates the genus.

14. Claims 1 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of copending Application No. 09/868,682. Although the conflicting claims are not identical, they are not patentably distinct from each other because receiving, integrating, synchronizing and evaluating of a goal related to a presentation regarding a time based model relates to receiving, integrating, managing and evaluating of a goal, especially since the species anticipates the genus.

15. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 112*

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "motivates" is a relative term and establishes claim 1 as indefinite.

### *Claim Rejections - 35 USC § 101*

18. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

19. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook et al (WO 97/44766 referred to as **Cook**).

**Claims 1, 10**

Cook anticipates(a) receiving information indicative of a goal (**Cook**, p 7, l 37); (b) integrating information that motivates accomplishment of the goal for use in the presentation (**Cook**, p 8, l 9); (c) synchronizing events in the presentation utilizing a time based model (**Cook**, p 1, l 5-8; Examiner's Note (EN): computers are synched with an internal clock); and (d) evaluating progress toward the goal and providing feedback that further motivates accomplishment of the goal utilizing the time based model to control the presentation of information (**Cook**, p 10, l 28-31; p 8, l 8-13).

**Claims 2, 11**

Cook anticipates including the step of presenting an interactive session and querying the user for analysis of the interactive session including a decision (**Cook**, p 7, l 19-29).

**Claims 3, 12**

Cook anticipates the step of altering the presentation based on the user's decision to further refine the accomplishment of the goal (**Cook**, p 7, l 19-29).

**Claims 4, 13**

Cook anticipates the step of advancing time as the presentation proceeds (**Cook**, p 7, l 19-29; EN: it is axiomatic that time will advance during the referenced events).

**Claims 5, 14**

Cook anticipates the step of presenting a new presentation and querying the user for a new decision after the time is advanced (**Cook**, p 101, l 1).

**Claims 6, 15**

Cook anticipates the step of simulating the management of resources utilizing the presentation (**Cook**, p 7, l 19-29; EN: such is a virtual tutor).

**Claims 7, 16**

Cook anticipates the step of adjusting the feedback based on a current time (**Cook**, p 7, l 19-29; EN: such is a virtual tutor exercising feedback).

**Claims 8, 17**

Cook anticipates the step of passing information from the presentation to an expert system to analyze the information and formulate the appropriate feedback utilizing time as one of the variables for analysis (**Cook**, p 7, l 19-29; EN: such is interaction ... feedback).

**Claims 9, 18**

Cook anticipates including the step of utilizing an internal clock to synchronize the time (**Cook**, p 1, l 5-8; EN: such is a computer's internal operation).

***Examination Considerations***

22. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris,* 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

23. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

24. Examiner's Opinion

Paras 18. and 19. apply. Examiner has full latitude to interpret each claim in the broadest reasonable sense.

***Conclusion***

25. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- Cook et al, U.S. Patent 5,727,950
- Lemelson et al, U.S Patent 5,823,788
- Rosen, U.S Patent 5,772,446
- Hekmatpour, U.S Patent 5,720,007

26. Claims 1-18 are rejected.

***Correspondence Information***

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (703) 308-3179.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

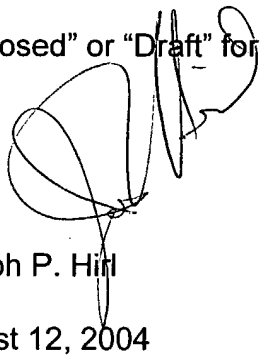
Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).



Joseph P. Hirl

August 12, 2004